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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/396,702	09/15/1999	ANOOP GUPTA	MS1-302US	7828

22801 7590 09/19/2002

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EXAMINER

MOFIZ, APU M

ART UNIT PAPER NUMBER

2175.

DATE MAILED: 09/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

10

Office Action Summary

Application No.

09/396,702

Applicant(s)

GUPTA ET AL.

Examiner

Apu M Mofiz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 and 28-33 is/are allowed.
- 6) ☒ Claim(s) 7-11 and 14-27 is/are rejected.
- 7) ☒ Claim(s) 12 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 and 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Allowable Subject Matter

1. Claims 1-6 and 28-33 are allowed over the prior art of records.

Claims 12-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art of records Jain et al. (U.S. Patent No. 6,144,375 and Jain hereinafter) and Purnaveja et al. (U.S. Patent No. 6,006,241 and Purnaveja hereinafter) do not disclose, teach or suggest the claimed limitations of (in combination with all other features in the claims) One or more computer-readable media containing a computer program for annotating streaming media, wherein the program performs steps, which includes creating annotations interactively with a user, wherein the annotations correspond to identified segments of one or more media streams; graphically ordering the annotations in a desired order of presentation in response to user input; and in response to a user instruction, sequentially presenting the annotations along with their corresponding identified media stream segments in the desired order of presentation as claimed in claims 1 and 28.

The prior art of records Jain et al. (U.S. Patent No. 6,144,375 and Jain hereinafter) and Purnaveja et al. (U.S. Patent No. 6,006,241 and Purnaveja hereinafter) do not disclose, teach or suggest the claimed limitations of (in combination with all other

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features in the claims) a method of receiving an indication of a plurality of annotations selected by a user, wherein each of the plurality of annotations corresponds to a media stream or to one or more media streams and seamlessly providing one or more of the plurality of annotations and at least a portion of the media stream corresponding to each of the plurality of annotations, presenting a plurality of annotation identifiers to the user and wherein the seamlessly providing comprises seamlessly providing the one or more of the plurality of annotations and the portion of the media stream corresponding to each of the plurality of annotations in an order defined by the order of the plurality of annotation identifiers and allowing the ordering of the plurality of annotation identifiers to be changed by the user as claimed in claim 12.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 7-11, 14-17 and 18-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of

Purnaveja et al. (U.S. Patent No. 6,006,241 and Purnaveja hereinafter. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the instant application are claiming common subject matter and they are substantially similar in scope and they use the same limitations, using varying terminology.

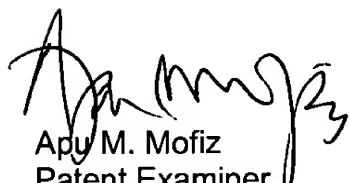
Claims 7-11,14-17 and 18-27 of the instant application corresponds to claims 1-18 of the 6,006,241 patent.

Points of Contact

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Apu M. Mofiz whose telephone number is (703) 605-4240. The examiner can normally be reached on Monday – Thursday 8:00 A.M. to 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached at (703) 3053830. The fax numbers for the group is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.


Apu M. Mofiz
Patent Examiner
Art Unit 2175


DIANE D. MIZRAHI
PRIMARY PATENT EXAMINER
TECHNOLOGY CENTER 2100

September 19,2002